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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,656	07/09/2003	Takashi Yoshizawa	763-37	9316
28249	7590	05/09/2005	EXAMINER	
DILWORTH & BARRESE, LLP			FRANCIS, FAYE	
333 EARLE OVINGTON BLVD.			ART UNIT	
UNIONDALE, NY 11553			PAPER NUMBER	

3728

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,656

Applicant(s)

YOSHIZAWA, TAKASHI

Examiner

Faye Francis

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-20 is/are rejected..
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of Group I in the reply filed on 1/31/05 is acknowledged. Accordingly, claim 3 is withdrawn from consideration as being directed to a non-elected invention

Accordingly, claims 1-2 and 4-20 will be further examined on the merits.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the button is situated on the lower cover in claims 15 and 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

Art Unit: 3728

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching that the button is situated on the lower cover, as recited in claims 15 and 18.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Taormina [6,170,651].

Taormina discloses in Figs 1-2, an eyeglass case 10 comprising: an upper cover [first closed end 26], a lower cover [second closed end 30], a button 46 which is secured to the lower cover and a rotating member [pivot point 50] which is secured to a contact portion [Fig 1] between the upper cover and the lower cover, wherein, when pushing the button for release, a spring 52 in the rotating member moves to slowly open the upper cover upwardly insofar as the applicant has claimed as recited in claims 1 and 12. Additionally, Taormina discloses a button-securing portion/ upper lock member [opposing ledge 48] situated upon upper cover as recited in claim 10, lower lock member [latch 44] situated upon lower cover as recited in claim 11.

Since the device disclosed in the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all the claimed functions including the ability to be opened with just a single hand by depressing the button.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taormina.

Taormina discloses most of the elements of these claims as stated above but for two rotating members respectively situated on lateral ends of the eyeglass case. It would have been obvious to one having ordinary skill in the art at the time the invention

Art Unit: 3728

was made to provide the device of Taormina with a second rotating members in order to have stronger attachment, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With respect to the button is situated on the upper cover: changing the location of the button from the proximate location shown by Taormina to a location on the upper cover, absent any criticality, is also considered an obvious modification of Taormina's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

6. Claims 2, 4-7 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taormina [6,170,651] in view of Lin [US 2003/0201265 A1].

Taormina discloses most of the elements of these claims as stated above.

Taormina does not disclose a support spindle wherein oil is sealed in the support spindle as recited in claim 2, to claim 4, wherein the outer housing is constituted by an outer cylindrical frame with the support spindle structured and arranged to fit into the frame along an inner circumferential wall thereof as recited in claim 5. Additionally, Taormina does not disclose protrusions extending from a lateral end wall of the outer cylindrical frame and inner lateral surface of the support spindle as recited in claim 6, button is situated on the upper cover as recited in claims 9 and 17.

Lin teaches the concept of providing a container to hold items having a pivoting cover 20 with two support spindle [pivot element 30] wherein oil [subsection 0041] is sealed in the support spindle, wherein the outer housing is constituted by an outer cylindrical frame [semi-sleeves 23 and 24] with the support spindle structured and arranged to fit into the frame along an inner circumferential wall thereof, protrusions extending from a lateral end wall of the outer cylindrical frame and inner lateral surface of the support spindle [subsection 0039]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the pivoting connection of device of Taormina with the slow pivoting connection as taught by Lin in order to reduce the noise while opening and closing the eyeglass case.

With respect to button is situated on the upper cover: changing the location of the button from the proximate location shown by Taormina to a location on the upper cover, absent any criticality, is also considered an obvious modification of Taormina's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



Faye Francis